

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Status of Claims:

No claims are currently being cancelled.

Claims 1, 2, 15-18, 31-34, 45 and 46 are currently being amended.

No claims are currently being added.

This amendment and reply amends claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-46 remain pending in this application.

Objection to the Specification and 35 U.S.C. § 112, 1st Paragraph Rejection of Claims 1, 15, 16, 17, 31, 32, 33, 45 and 46:

In the Office Action, the specification was objected to, and claims 1, 15, 16, 17, 31, 32, 33, 45 and 46 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, because the specification allegedly does not provide support for “storing a secret in memory of the personal communication device **prior to a user** of the personal communication device **acquiring the personal communication device** (emphasis added).”

Applicant respectfully disagrees. Paragraph 0050 of the specification clearly states that “the user 24 may be provided with the **password already stored on a SIM 10 supplied with their phone** or provided subsequently.” (emphasis added). Thus, when a user acquires a phone, a SIM 10 with a password stored therein is already provided with the phone in one possible situation that is clearly considered in the specification. Each of the presently pending claims has been amended to recite “storing a secret in memory of the personal communication device **prior to a user** of the personal communication device **being supplied with the personal communication device**.” While the previously-recited features were believed to be supported by the specification, the Examiner might have been referring to a strange situation whereby a user purchases (and thus “acquires” in some sense) a phone prior

to the phone being fitted with a SIM card, whereby the presently pending independent claims have been amended to use the word “being supplied with” instead of “acquires” in order to clearly cover the features discussed above in paragraph 0050 of the specification.

Accordingly, all of the presently pending claims fully comply with 35 U.S.C. § 112, first paragraph, and the specification is unobjectionable.

Claim Rejections – Prior Art:

In the Office Action, claims 1-10, 13-26, 29-42, 45 and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,724,4234 to Khello in view of WO 00/31608 to Tuneld et al.; and claims 11, 12, 27, 28, 43 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Khello in view of Tuneld et al. and further in view of U.K. Patent No. 2,324,682 to Hayashi et al. These rejections are traversed with respect to the presently pending claims, for at least the reasons given below.

Khello and Tuneld:

As explained in the previously-filed response, in Khello, a user uses a portable user authentication coating device which includes an on/off key to enable/disable the authentication service in which it is such that the user is prompted to either key-in or audibly enter a PIN. After the entry of the PIN, the user presses the END button to initiate encoding and transmission to the user authentication device center.

Page 4, lines 24-25 of the Office Action acknowledges this distinction, but incorrectly refers to Tuneld for allegedly disclosing this feature.

Page 1, lines 18-21 of Tuneld (cited in the Office Action as allegedly disclosing the features missing in Khello) merely describes a SIM card, and says nothing about when information is stored in that SIM card. In the presently claimed invention, the secret information is stored in the SIM card prior to the user being supplied with the phone, whereby a SIM card clearly can store information after the user is supplied with the phone.

Page 2, lines 15-24 of Tuneld (cited in the Office Action as allegedly disclosing the features missing in Khello) describes that a user is required to enter in a Personal Identification Number (PIN), prior to be allowed access to a computer. Like the other recited portion of Tuneld, this does not teach or suggest the above-mentioned features of the

presently pending claims in which a secret is stored in a memory of the personal communication device **prior to a user** of the personal communication device **being supplied with the personal communication device.**

Lastly, page 4, lines 14-18 of Tuneld (cited in the Office Action as allegedly disclosing the features missing in Khello) describes that a user inserts a SIM 120 into a mobile telephone. However, in the presently claimed invention, the SIM has already stored within it one or more secrets, prior to a user being supplied with the phone. Clearly, page 4, lines 14-18 of Tuneld teaches that the user has been supplied with a mobile phone 110, whereby the user can then insert a SIM 120 into the mobile phone 110, and whereby the user can then presumably store information into the SIM 120 separate from information already stored in the SIM 120 during a manufacturing process of the SIM 120.

Thus, each of the presently pending independent claims under rejection is patentable over the combination of Khello and Tuneld.

Since Hayashi does not rectify the above-mentioned deficiencies of Khello and Tuneld, claims 11, 12, 27, 28, 43 and 44 are patentable over the combined teachings of these three references.

Furthermore, please note that dependent claims 2, 18 and 34 have been amended to include features described in paragraphs 0045 and 0046 of the specification, whereby such features are believed to provide a separate basis of patentability for those claims, beyond the reasons provided above for their respective base claim.

Conclusion:

Since all of the issues raised in the Office Action have been addressed in this Amendment and Reply, Applicant believes that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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